

Because the above claim amendments merely cancel two dependent claims and incorporate the subject matter thereof into their corresponding independent claims, no new matter is being introduced and no new search is necessitated. The requirements of 37 C.F.R. § 1.116 are therefore believed to be satisfied and entry of the above claim amendments is respectfully requested.

Claims 1, 2, 5, 7 to 9, and 11 remain rejected under 35 U.S.C. § 103(a) over U.S. Patent 5,421,765 (Lehmann) in view of U.S. Patent 5,290,043 (Vidinic); claims 1, 2 and 4 to 9, and 11 remain rejected under 35 U.S.C. § 103(a) over Lehmann in view of U.S. Patent 5,136,726 (Kellin); and claims 11 to 19 remain rejected under 35 U.S.C. § 103(a) over French Patent Application 764,103 (Penataro) in view of Lehmann. Withdrawal of these rejections is respectfully requested for the following reasons.

Independent claim 1 is directed to decorating a shoe by wetting a stick-on tattoo and applying the stick-on tattoo to a smooth outer surface of the shoe, in which the stick-on tattoo does not include separate adhesive material. Independent claim 11 is directed to a decorated shoe with a stick-on tattoo attached to a smooth portion of the outer surface of the shoe, in which the stick-on tattoo does not include separate adhesive material.

The applied art does not disclose or suggest at least the feature of a stick-on tattoo that does not include separate adhesive material adhering to a smooth outer surface of a shoe. In this regard, Lehmann only discusses applying an adhesive-backed tattoo (in the nature of a sticker) to clothing, skin, hair or toys. Specifically, lines

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3 to 8 of Lehmann's Abstract and column 3, lines 3 to 6, of Lehmann's Specification clearly state that his tattoos are adhesive-backed. Moreover, Lehmann says nothing at all about applying any other type of tattoo to a shoe.

Vidinic discusses applying articles to shoes, but appears only to contemplate attaching Velcro-backed patches or adhesive-backed stickers. See column 3, lines 32 to 34.

Kellin discusses placing detachable decorative elements on different articles of apparel, such as boots, shoes, caps, belts and backpacks. However, Kellin's decorative articles are attached using Velcro. Specifically, in Kellin substantially all exposed cloth surfaces of the articles of apparel are made of a stretchable "loop" fabric (column 2, lines 60 to 62), thereby permitting decorative articles having a "hooked" backing to be applied to such apparel (column 3, lines 57 to 60).

Pentaro only appears to disclose use of a protective strip on a shoe. Therefore, Penataro is not believed to be applicable to the present invention at all.

As a result, none of Lehmann, Vidinic, Kellin or Pentaro discloses or suggests a stick-on tattoo that does not include separate adhesive material adhering to a smooth outer surface of a shoe. In fact, the applied art does not discuss any use at all of a stick-on tattoo that does not include separate adhesive material.

In this regard, MPEP § 2142 requires that in order to establish a *prima facie* case of obviousness, the Examiner must cite prior art references that teach or suggest all of the claim limitations and, if more than one such reference is required to disclose all such limitations, there must be some suggestion or motivation, either in the prior art

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings.

However, the applied art clearly does not show at least the above-referenced feature of the invention. Accordingly, it is not believed that any permissible combination of the applied art would have rendered claims 1 and 11 obvious.

Claims 1 and 11 are therefore believed allowable over the applied art.

The other rejected claims in this application depend from the independent claims discussed above, and are therefore believed to be allowable for at least the same reasons. Because each dependent claim also defines an additional aspect of the invention, however, the individual reconsideration of each on its own merits is respectfully requested.

In view of the foregoing remarks, it is believed that the entire application is in condition for allowance, and an indication to that effect is respectfully requested.

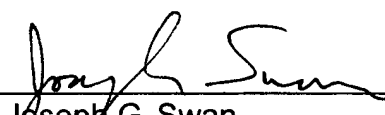
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Respectfully submitted,

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